

REMARKS/ARGUMENTS

Claims 17, 19, 21, 22, 24-26, and 28-40 remain in this application.

Rejection Under 35 USC 112, First Paragraph

Claims 17, 19, and 21-22, 24-26, and 28 were rejected under 35 USC 112, first paragraph. See Pages 3-4 of the Office Action. According to the Office Action, “the skilled artisan would view that regulating the firmness or tone of skin of a subject or regulat[ing] wrinkles in skin of a subject, including preventing, retarding, arresting, or reversing the wrinkles in the skin, are highly unlikely Therefore . . . to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to achieve methods of regulating the firmness or tone of skin of a subject or regulat[ing] wrinkles in skin of a subject, including preventing, retarding, arresting, or reversing the wrinkles in the skin, with no assurance of success.” See Pages 2-3 of the Office Action. The Applicants respectfully disagree.

As stated in the previous amendment filed on May 8, 2003, the term “topical application” is defined on page 2, lines 24-26 of the specification, the term “cosmetically-acceptable” is defined on page 2, lines 27-33, and the term “safe and effective amount” is defined on page 4, lines 1-14 of the specification. The specification also provides various examples of topical compositions and/or carriers, for example, on page 5, line 17 through page 9, line 3. Accordingly, the specification does provide information that would allow the skilled artisan to practice the instant invention.

Furthermore, the Office Action asserts that the claimed method are “highly unlikely,” stating “over the years many attempts at stopping the aging process have been recorded. However, they have later been proven unsuccessful. There is no fountain of youth.” See page 3 of the Office Action. No support for these assertions, however, is provided in the Office Action. In any event, Applicants claims do not state that the aging process is stopped, as asserted in the Office Action. Rather, Applicants recite methods of regulating the firmness or tone of skin of a subject or regulating wrinkles in skin. Also, contrary to the assertions in the Office Action, compositions have been shown to achieve such regulation. For example, the product Renova®, the label of which is attached hereto as Exhibit A, has been approved by the FDA for use in the mitigation (palliation) of fine wrinkles, mottled hyperpigmentation, and tactile roughness of

facial skin. Applicants, therefore, respectfully request that the above rejection under Section 35 USC 112, first paragraph, be withdrawn.

Rejection Under 35 USC 102

Claims 17, 19, and 21-22, 24-26, and 28 were rejected under 35 USC 102(b) as being anticipated by Japanese Patent 61291515 (the “515 Patent”). See Pages 5-6 of the Office Action. According to the Office Action, the method of the ‘515 Patent “inherently treats the skin in a subject for regulating the firmness, tone, or texture of skin of a subject or for regulating wrinkles in skin of a subject . . . since [the ‘515 Patent] method steps are same as the instant method steps.” See Page 6 of the Office Action.

Applicants respectfully disagree. However, in the interests of furthering this application to allowance, Applicants have amended claim 17 to recite the topical administration of the composition to the skin of said subject in need of such regulating. The ‘515 Patent does not disclose the topical application of such a composition to such skin. Rather, the ‘515 Patent discloses the application to sunburned skin, to rough skin, razor rashed skin, and inflamed skin. As previously stated in the prior amendment, Section 2112.02 of the M.P.E.P. states “The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using.” The ‘515 Patent does not teach the topical application of a composition to the skin of said subject in need of regulating its firmness or tone or regulating its wrinkles.

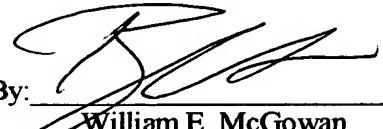
Furthermore, as set forth in In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’ The skin that is treated in the ‘515 Patent would not necessarily be in need be in need of regulation of firmness, tone, or wrinkles, as now recited in claim 17.

Accordingly, Applicants respectfully request the withdrawal of the above rejection under 35 USC 102(b).

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Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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